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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/069,709

02/26/2002

Akira Ogino

SONYJP-183

5278

7590

05/19/2004

Lerner David Littenberg Krumholz & Mentlik
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Westfield, NJ 07090

EXAMINER

VENT, JAMIE J

ART UNIT	PAPER NUMBER
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2613

DATE MAILED: 05/19/2004

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/069,709

Applicant(s)

OGINO, AKIRA

Examiner

Jamie Vent

Art Unit

2613

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,7-10,14 and 16-20 is/are rejected.
- 7) ☒ Claim(s) 2-4,6,11-13 and 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 5, 7, 8, 9, 10, 14, 16, 17, 18, 19, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Sugita et al (US 6,381,402).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

[claims 1 & 10]

In regard to Claims 1 and 10, Sugita et al, discloses an information inserting apparatus and method for superimposing additional information to main information signals, comprising:

- Generating first insertion signals from the additional information and generating second insertion signals from the additional information (Column 2 Lines 65+ and Column 3 Lines 1-4 describe the generation of the first signal and generating the changing the duplication control signal, thereby becoming the second signal, and adding additional information); and
- Superimposing the respective insertion signal generated from the insertion signal generating means to the main information signals (Column 4 Lines 62+ and Column 5 Lines 1-5 describes the superimposing of the insertion signal).

[claims 5 & 14]

In regard to Claims 5 and 14, Sugita et al discloses the inserting apparatus and method wherein the superimposing means superimposes the first insertion signals and the second insertion signals to a plurality of regions of the main information signals, which regions are obtained by dividing signal units constituting the main information signals (Column 13 Lines 4-10 describe the method and apparatus of recording the duplication control signal by interpolating the data with areas divided).

[claims 7 & 16]

In regard to Claims 7 and 16, Sugita et al discloses an inserting apparatus and method wherein the insertion signal generating means generates the first insertion signals and the second insertion signals from identical additional information (Column 6 Lines 3-4 describe the first and second insertion signals/ duplication data as to be “originally identical”).

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[claims 8 & 17]

In regard to Claims 8 and 17, Sugita et al discloses an inserting apparatus and method wherein inserting signal generating means generates the first insertion signals and the second insertion signals by the use of key information, and generates different insertion signals by the use of key information, and generates different insertion signals from the additional information by varying the key information to be used (Column 11 Lines 18-30 describe varying the information to be used by the use of varying timing signals supplied by the timing generator)..

[claims 9 & 18]

In regard to Claims 9 and 18, Sugita et al discloses inserting apparatus and method wherein the insertion signal generating means generates different insertion signals from the additional information by varying the encoding method (Figure 8 element 22 shows the coding unit which uses varying encoding methods as further described in Column 11 Lines 7-12).

[claim 19]

In regard to Claim 19, Sugita et al discloses a recording medium which has recorded therein signals being main information signals having superimposed thereto additional information, wherein first insertion signals generated from the additional information and second insertion signals generated from the additional information are multiplexed and superimposed to the main information signals (Figure 10 shows the multiplexing and superimposing of the first and second insertion signals onto one main signal as seen the conversion of signals onto element 15).

[claim 20]

In regard to Claim 20, Sugita et al discloses a recording medium which has recorded therein signals being main information signals having superimposed thereto additional information, wherein the recording medium is manufactured by undergoing the steps of:

- Generating first insertion signals from the additional information and generating second insertion signals from the additional information (Column 2 Lines 65+ and Column 3 Lines 1-4 describe the generation of the first signal and generating the changing the duplication control signal, thereby becoming the second signal, and adding additional information);
- Superimposing the respective insertion signals generated in the insertion signal generating step to the main information signals (Column 4 Lines 62+ and Column 5 Lines 1-5 describes the superimposing of the insertion signal); and
- Recording signal having superimposed thereto the respective insertion signals generated in the insertion signal-superimposing step to the recording medium (Figure 2 shows the generation of the insertion signal and superimposing step which is sent to the recording medium as seen in Figure 1 element 123)

[claims 2, 3, 4, 6, 11, 12, 13, & 15]

Claims 2, 3, 4, 6, 11, 12, 13, and 15 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon are considered pertinent to applicant's disclosure. The following is considered of significant interest to the application:

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- Moriwaki et al (US 6,466,617); and
- Ikeda et al (US 6,470,137)

Contact Fax Information

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

Or faxed to:

703.208.6306 (for formal communication intended for entry)
703.308.5359 (for informal or draft communications, please label "PROPOSED"
or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

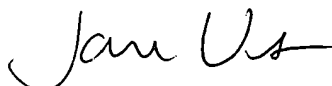
Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamie J. Vent whose telephone number is (703) 305-0378.

If any attempts to reach the examiner by telephone are unsuccessful, the examiners supervisor, Christopher Kelley, can be reached at (703) 305-4856.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Miss Jamie Vent
05/12/2004



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